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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,506	10/30/2001	Niall Morrison Barr Martin	0655435-9009	8516
23510	7590	11/26/2003	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP ONE SOUTH PINCKNEY STREET P O BOX 1806 MADISON, WI 53701			FORD, JOHN M	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,506	MARTIN ET AL.	
	Examiner	Art Unit	
	John M Ford	1624	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on NOV 05, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1--4 AND 10--25 is/are pending in the application.
- 4a) Of the above claim(s) 1--4 AND 10--19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20--25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/21/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

The claims in the application are claims 1—4 and 10—25.

Applicants elected claims 20—25 in a response of 11-5-2003.

Once an allowable genus is arrived at, in the ~~course~~^{of} prosecution, the question of rejoinder of the non-elected claims will be considered. Claims 13—19, likely, will be rejoined, if they are of the same scope as claim 20.

Claim 20 is rejected under 35 U.S.C. 112, 2nd and 1st paragraphs. Line 3, what is intended by “solvate”, what solvents were used?² How is it bonded to the diazine? Where is it bonded? ~~Are~~ these covalent bonds? What is the structure of the product?

Chemically protected form cannot be allowed. What is that?

Pro~~drug~~ is an entirely different invention. What is the pro ~~drug~~? That would require considerable experimentation to determine what compound; perhaps a terminal diamine would be cyclicized by the body ~~to~~^{to} form the instant cyclic diazine.

A ~~&~~ B are a fused aromatic ring! What aromatic ring? Fused how? *a, b, c,*
d. What side of the ring is fused to the diazine.

The unknowns mount with “substituted.” The Supreme Court in 1928 objected to the unknown nature of “substituted” in *Corona vs. Dovan* 1928 USSC; 1928 C.D. 253; 276 U.S. 358.

R2 is rejected, for the above noted reasons, as no one knows what the phenyl is substituted with.

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Claims 21 – 25 *are rejected as being dependent on a rejected claim.*

The restriction requirement is maintained, for the present, as a disease mediated by PARP in claim 1 does not rise to the level of a “specific” would of Commerce disease.

The Supreme Court declined to express a view as to whether patentability can be based on a product shown to inhibit the growth of tumors in laboratory animals. Brenner, Comr., Pats. V. Manson, (U.S.C. 1966) 383 US 519, 148 USPQ 689. The Court did state, however, that congress did not intend that a patent be granted on a chemical compound, or a process for its production, whose sole “utility” consists of its potential role as an object of use-testing, reasoning the patent system is related to the World of Commerce, rather than the realm of philosophy ibid., 148 USPQ at 696.

The recent utility guidelines set by PTO require applicants to meet the requirements as stated in Brenner v. Manson in 148 USPQ 689 refers to. The standard set forth in the concurring opinion of In re Hardtop, 135 USPQ 419 is “whether the invention has been brought to such perfection as to be capable of practical employment.” This language is echoed in Bindra vs. Kelly, 206 USPQ 570.

Patents are issued by the Commerce Dept. to stimulate Commerce. The Court reasoned that the utility should relate to the Real World of Commerce, that would be understandable, not a laboratory curiosity or a broad assay for many possible diseases.

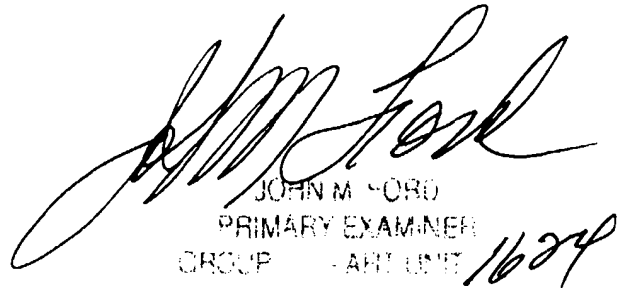
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37 CFR 1.105
Completeness of examiner's action.

The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

J. M. Ford:jmr

November 24, 2003


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT *1624*